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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
CHOI, MICHAEL P				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/544,196

Applicant(s)

VERHAEGH ET AL.

Examiner

Michael Choi

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 10-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10-12 recite "software for installation". This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

However, in contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035 (MPEP 2106.01.I). Any amendment to the claim would be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellis et al. (US 2002/0174430 A1).

Regarding Claim 1, Ellis et al. teaches a data processing system for recording content items in a storage medium (Paragraphs [0473,0481]), wherein:

- the system maintains a list with at least a particular one of the recorded content items scheduled for being deleted (Figs. 52-55B; Paragraphs [0358,0362,0363]) from the storage medium (Paragraph [0025]) to provide storage capacity for a new content item scheduled for being recorded (Paragraph [0202,0318] – deletion to provide storage for recorded items); and
- the system has an output for providing a representation of the list indicating an order wherein the particular recorded items are scheduled for being deleted (Figs. 52-55 – delete priority order).

Regarding Claim 2, Ellis et al. teaches the system of claim 1, operative to notify the user of the list upon a predetermined event (in at least Figs. 35, 2126; 37, 2330 - deletion priority).

Regarding Claim 3, Ellis et al. teaches the system of claim 1, operative to enable a user to modify the list (in at least Figs. 37, 2330; 38; 51-55 - edit setup of deletion along with moving up or down; Paragraphs [0351-0361] – user enablement of selection and modification).

Regarding Claim 4, Ellis et al. teaches the system of claim 3, enabling a user to modify the order (in at least Figs. 37, 2330; 38; 51-55 - edit setup of deletion along with moving up or down; Paragraphs [0351-0361] – user enablement of selection and modification).

Regarding Claim 5, Ellis et al. teaches a method of providing a service to a user, the method comprising:

- controlling storage capacity for storing electronic content items (Figs. 9, 920; 10; Paragraphs [0219,0220] – recording space available);
- maintaining a list with at least a particular one of the recorded content items scheduled for being deleted (Figs. 52-55B; Paragraphs [0358,0362,0363]) to provide storage capacity for a new content item scheduled for being recorded (Paragraph [0202,0318] – deletion to provide storage for recorded items); and
- providing a representation of the list indicating an order wherein the particular items are scheduled for being deleted (Figs. 52-55 – delete priority order).

Regarding Claim 6, Ellis et al. teaches the method of claim 5, comprising enabling a user to be notified of the list (in at least Figs. 35, 2126; 37, 2330 - deletion priority).

Regarding Claim 7, Ellis et al. teaches the method of claim 5, comprising enabling a user to modify the list (in at least Figs. 37, 2330; 38; 51-55 - edit setup of deletion along with moving up or down; Paragraphs [0351-0361] – user enablement of selection and modification).

Regarding Claim 8, Ellis et al. teaches the method of claim 7, comprising enabling the user to modify the order (in at least Figs. 37, 2330; 38; 51-55 - edit setup of deletion along with moving up or down; Paragraphs [0351-0361] – user enablement of selection and modification).

Regarding Claim 9, Ellis et al. teaches the method of claim 5, comprising providing the storage capacity (Figs. 9, 920; 10; Paragraphs [0219,0220] – recording space available).

Regarding Claim 10, Ellis et al. teaches Software for installation on a PVR for (Paragraph [0179]):

- enabling to maintain a list with one or more particular ones of multiple content items recorded at the PVR (Paragraphs [0010-0014;0023-0026]) that are scheduled for being deleted (Figs. 52-55B; Paragraphs [0358,0362,0363]) to provide storage capacity for a new content item scheduled for being recorded (Paragraph [0202,0318] – deletion to provide storage for recorded items); and for
- enabling to provide a representation of the list indicating an order wherein the particular items are scheduled for being deleted (Figs. 52-55 – delete priority order).

Regarding Claim 11, Ellis et al. teaches the software of claim 10, enabling the user to modify the list (in at least Figs. 37, 2330; 38; 51-55 - edit setup of deletion along with moving up or down; Paragraphs [0351-0361] – user enablement of selection and modification).

Regarding Claim 12, Ellis et al. teaches the software of claim 10, enabling the user to modify the order (in at least Figs. 37, 2330; 38; 51-55 - edit setup of deletion along with moving up or down; Paragraphs [0351-0361] – user enablement of selection and modification).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Choi whose telephone number is (571) 272-9594. The examiner can normally be reached on Monday - Friday 9:00AM - 5:30PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621
/M. C./
Examiner, Art Unit 2621